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Malachuk
Name

June 10, 2003
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Gregg B. Morin et al.

Filing Date: July 11, 2000

Serial No: 09/615,039

Docket: 019/251c

Title: ONCOLYTIC VIRUS THAT REPLICATES
IN CELLS EXPRESSING TELOMERASE
REVERSE TRANSCRIPTASE

Art Unit: 1632

Examiner: Michael C. Wilson

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JUN 17 2003
TECH CENTER 1600/2900

**PETITION UNDER 37 CFR § 1.181(a) OR § 1.137(b)
TO WITHDRAW HOLDING OF ABANDONMENT**

Commissioner for Patents
Alexandria VA 22313

Dear Sir,

A Notice of Abandonment was issued in this application on May 29, 2003. Applicant received the Notice on June 3, 2003.

Applicant hereby petitions the Office to withdraw the holding of Abandonment under 37 CFR § 1.181(a), as being incorrectly issued. In the event the Office decides not to grant the Petition under § 1.181(a), applicant hereby petitions the Office to revive the application under § 1.137(b).

History of the application

The events leading up to the mailing of the Notice of Abandonment on May 29, 2003, according to records in the prosecution file at Geron Corporation are as follows:

- The application was filed on July 11, 2000, with all the component parts required under 37 CFR § 1.51, including the Declaration and filing fee.
- A Restriction Requirement was issued on October 3, 2001, and mailed to the wrong address, even though the application papers properly indicated the correct correspondence address for this application.
- On May 28, 2002, Examiner Qian J. Li and the undersigned spoke by telephone. Examiner Li indicated that a Restriction had been made, requiring applicant to make an election between three groups. As representative of the assignee, the undersigned elected Group I for prosecution on the merits without traverse. The undersigned also authorized the Office to charge any fees required for extensions of time or reinstatement of the application to applicant's deposit account. Examiner Li indicated that in view of the election made, an Office Action would now be prepared on the merits of the elected invention. (A copy of the interview summary from applicant's file is enclosed herewith.)
- On May 29, 2002, the Office mailed a written action, reiterating the same Restriction Requirement that was the subject of the telephone interview of May 28. The paper was prepared by Peter Brunovskis and signed by Deborah Crouch. Examiner Deborah Reynolds is indicated on the cover sheet as being the Examiner in charge.
- The undersigned called Examiner Reynolds to explain that a telephone election had already been made. Examiner Reynolds indicated that the Examiner originally assigned to the case had left the Office. She indicated the time for responding to the Restriction Requirement would be restarted, and that the election made by telephone would be entered and forwarded with the case to a new examiner for preparation of the first Office Action on the merits.
- As of August 2002, PAIR showed that an Action had not yet been mailed by the Office. In an abundance of caution, the undersigned prepared a written Interview Summary and Response to Restriction Requirement, for filing by fax on August 29, 2002.

- In preparation for a trip to the Patent Office in March of 2003, the undersigned again contacted Examiner Reynolds to determine the status of this application. The application file had apparently gone missing, and had not yet been assigned to a new examiner. The undersigned is grateful to Examiner Reynolds for her efforts to guide the application back into the proper channel for examination by the Patent Office.
- On May 20, 2003, Examiner Michael Wilson called to inform the undersigned that a response to the Restriction Requirement had not been received. The undersigned indicated that a response to the Restriction Requirement had been made by telephone on May 28, 2002, and sent Examiner Wilson a copy of the papers sent by fax on August 29, 2002.
- On May 29, 2003, the Office mailed a Notice of Abandonment, and an Interview Summary indicating that applicant's papers indicated that the facsimile transmission made on August 29, 2002, had "failed". The Office apparently neglected to consider that the papers sent on August 12 merely confirmed that a response to the Restriction Requirement was properly made by telephone on May 28, 2002.
- Upon receiving the Notice of Abandonment on June 3, 2003, the undersigned diligently prepared and filed this Petition.

Petition under 37 CFR § 1.181(a)

Applicant hereby petitions the Office to withdraw the holding of abandonment with respect to this application. The Notice of Abandonment is incorrect because it indicates that applicant failed to timely file a response to the Restriction Requirement.

In fact, applicant responded to the restriction in question when it was made on May 28, 2002, according to the telephone restriction practice of MPEP § 812.01. Two different Examiners assured the undersigned on two separate occasions that the election made by telephone would be entered into the file as a complete response to the Restriction. The written action mailed on May 29, 2002 did nothing more than reiterate the same Restriction made by telephone.

There is no obligation for applicants to respond to a telephone restriction in writing (MPEP § 812.01). There is also no obligation for applicants to respond to papers mailed in duplicate or in error when the substance of the action has already been dealt with.

Accordingly, the Notice of Abandonment of May 29, 2003 has been issued in error. Withdrawal of the Notice of Abandonment under 37 CFR § 1.181(a) is respectfully requested.

Since this Petition has been necessitated due to circumstances beyond applicant's control, no fee is due, as indicated in MPEP § 711.03(c)(I).

Petition under 37 CFR § 1.137(b)

In the event that the Office decides not to grant applicant's request to withdraw the holding of abandonment under § 1.181(a), applicant hereby petitions the Office to revive this application pursuant to § 1.137(b) as having gone abandoned unintentionally.

In support of the request under § 1.137(b), the Commissioner is hereby authorized to charge Deposit Account No. 07-1139 with the small entity fee under 37 CFR § 1.17(m), which is believed to be \$650.

In response to the Restriction Requirement, the Office is requested to enter into the file the paper entitled "Interview Summary and Response to Restriction Requirement", dated August 29, 2002, a copy of which is enclosed herewith.

Until receipt of the Notice of Allowance, the undersigned believed that all applicant's obligations to keep this application under consideration had been complied with. The entire delay in filing the required reply from the due date for the reply until the filing of this grantable petition pursuant to 37 CFR § 1.137(b) has been unintentional.

Request for expedited processing under 37 CFR § 1.102(a)

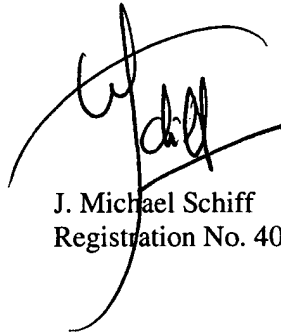
This disclosure advances clinical therapy by providing an important new system believed to be useful for cancer therapy. The technology is the subject of a license agreement. Corresponding applications have been granted in Australia (AU 38563/00), and are under active prosecution in other foreign jurisdictions, as being a potentially important contribution to the art of clinical therapy and of commercial interest to Geron Corporation.

Examination of this application on the merits has been unnecessarily delayed since October 3, 2001. The Office has made several errors in the processing of this application, including mailing of the original Restriction Requirement to the wrong address, failure to enter the response to the telephone restriction into the file, and delay in processing the file after the deadline for responding to the restriction. The compounded delay has been 21 months, plus the time required to consider this Petition.

As a remedy, applicant respectfully requests that this application be given special consideration upon order of the Commissioner, pursuant to § 1.102(a), without charge to applicant.

Other than the request under 37 CFR § 1.102(a), should the Patent Office determine that a further extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Michael Schiff', is written over a large, stylized, handwritten 'X' or checkmark.

J. Michael Schiff
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June 10, 2003